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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,775	11/15/2000	Jae-Young Jung	12568-002001 / OPP 000771	3088

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FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

YEE, DEBORAH

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/713,775	JUNG, JAE-YOUNG <i>g</i>
Examiner	Art Unit	
Deborah Yee	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 June 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11/5/00 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____ .
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>15</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1 to 8 have been considered but are moot in view of the new ground(s) of rejection. The Final Rejection of paper no. 14 dated March 7, 2003 has been withdrawn and applicant' amendment filed June 11, 2003 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 to 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 2742948 or Japanese patent 7-242935, which were submitted by applicant in IDS filed June 11, 2003.

The English abstract of JP'948 and JP'935, each teach a martensitic steel alloy with constituents whose wt% ranges overlap those recited by the claims; such overlap renders applicant's composition *prima facie* obvious despite differences in non-overlapping areas, see *In re Malagari*, 182USPQ549 and MPEP2112.01.

More specifically, JP'948 discloses examples 9, 23,24, and 26 which meet the claimed composition except contain slightly lower amounts of Nitrogen. Since applicant has not demonstrated criticality of the 0.11 to 0.25% Nitrogen range (e.g. by comparative test data), then it would seem that a composition with 0.11% N vs. a

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composition with slightly less (say 0.081%) would depict a mere difference in the proportion of element without any attendant unexpected results, which would not patentably distinguish claims over prior art. Moreover, applicant's N range of 0.11 to 0.25% N fails to define patentable novelty over JP'948 whose N range is 0.03 to 0.15% because there is nothing to show (e.g. test data) that the more narrowly claimed N range is critical or that it involve anything more than judicious selection. Note that a N range of 0.05 to 0.25% is permissible in applicant's original claim 1, and a preferred range of 0.08 to 0.2% is disclosed on page 8 of applicant's specification.

JP'935, also, discloses specific examples 215, 226, 244, and 273 on pages 28 to 34 which meet the claimed composition except for slightly higher amount of one element. Criticality of applicant's more narrowly claimed ranges needs to be established to define claims over prior art.

In regard to process claims, the English abstract of JP'948 discloses subjecting steel alloy to austenitizing and tempering at 580C to Ac1. Although prior art tempering at 580C is slightly higher than the claimed tempering range of 350-575C, such would not be patentable distinction since tempering temperature is a matter of choice and routine optimization depending on the desired amount of softening and stress relief required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 703-308-1102. The examiner can normally be reached on Monday-Friday from 6:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-873-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

dy
June 18, 2003

Deborah Yee
DEBORAH YEE
PRIMARY EXAMINER